



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,993	06/14/2001	James A. Johnston	US010384	4698

24737 7590 09/15/2006

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER

GOTTSCHALK, MARTIN A

ART UNIT PAPER NUMBER

3626

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,993

Applicant(s)

JOHNSTON ET AL.

Examiner

Martin A. Gottschalk

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. Claims 1-29 are pending and remain unamended.

Note: The following claim rejections are reproduced here for the convenience of the reader. The claims are unamended.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 7-17, and 19-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Taylor et al (US Pat# 6,209,004, hereinafter Taylor).

A. As per claim 1, Taylor discloses a patient evaluation apparatus (Taylor: col 9, Ins 56-62; cols 13-16, sections VII to X), comprising:

Art Unit: 3626

- (a) a configuration module including a configuration database of form data for a medical evaluation form (Taylor: col 4, lns 11-13; Fig 4, Block 2);
- (b) a dynamic generator to create a marked up document based upon the form data (Taylor: col 8, lns 21-22 and 34-37; Fig 4, Block 7); and
- (c) a transmitting module to

combine the marked up document with medical data of a patient (Taylor: col 8, lns 20-28 and 34-37; Fig 4, Blocks 2-4 and 7) and

transmitting the combined marked up document through a transmission channel (Taylor: col 8, lns 29-33, Fig 4, Block 5), such that a user having a browser is capable of receiving and displaying the combined marked up document (Taylor: col 5, lns 17-22, note the use of the Internet; also lns 31-37, note the exemplary use of Microsoft Word which generates files of many different formats including Word format and HTML format.).

B. As per claim 2, Taylor discloses the patient evaluation apparatus of claim 1, further comprising

a patient data object to store the medical data, the medical data being entered by the user in the received combined marked up document (Taylor: col 7, lns 49-55; Fig 2, Block 19).

C. As per claim 3, Taylor discloses the patient evaluation apparatus of claim 2, wherein

the patient evaluation apparatus performs a search for the medical data in a patient database and stores found patient's records in the patient data object (Taylor: col 3, lns 54-59; col 7, lns 55-58; Fig 2, Block 20;).

D. As per claim 4, Taylor discloses the patient evaluation apparatus of claim 3, wherein

the user may alter medical data stored in the patient data object by entering different medical data over the medical data combined in the combined received marked up document (Taylor: col 4, lns 38-45, reads on "...existing data item in a document is edited...").

E. As per claim 5, Taylor discloses the patient evaluation apparatus of claim 1, wherein

the configuration module checks the configuration database to determine whether the configuration database has changed, and upon a change of the

Art Unit: 3626

configuration database the configuration module causes the dynamic generator to re-create the marked up document (Taylor: col 4, lns 5-17, reads on "...automatic regeneration of all Dependent documents..."; see also lns 22-24).

F. As per claim 7, Taylor discloses the patient evaluation apparatus of claim 1, further comprising:

an authorization module to determine whether the user is permitted to view a received combined marked up document (Taylor: col 4, lns 17-22).

G. As per claim 8, Taylor discloses patient evaluation method, comprising:

dynamically creating a marked up document based on a configuration database, with the configuration database including form data for medical evaluation forms (rejected as per the steps of claim 1a and 1b above);

combining the marked up document with medical data of a patient (rejected as per the step of claim 1c above; also Fig 2, Blocks 12 to 14); and

transmitting the combined marked up document through a transmission channel to a user having a browser capable of receiving and displaying the received marked up document (rejected as per the step of claim 1c above; see also Taylor: col 18, lns 37-

Art Unit: 3626

41).

H. As per claim 9, Taylor discloses the patient evaluation method of claim 8, further comprising

monitoring for a user alteration of the medical data in the received marked up document (rejected as per claim 4 above).

I. As per claim 10, Taylor discloses the patient evaluation method of claim 9, wherein

the user altered medical data is caused to replace the medical data in a patient database that stored the medical data (rejected as per claim 4 above).

J. As per claim 11, Taylor discloses the patient evaluation method of claim 8, further comprising

storing a user alteration of the medical data in the received marked up document (rejected as per claim 4 above. The Examiner considers an "update" to include storage of altered data) and

storing the alteration of medical data in a patient database if it is determined that a break in the transmission channel to the user has occurred (rejected as per claim 4 above. The Examiner considers an “update” to include storage. See also col 18, Ins 37-41. The Examiner considers the end of the addition of altered data to be a form of break in the transmission, which would be followed by storage of the data).

K. As per claim 12, Taylor discloses the patient evaluation method of claim 8, further comprising

storing a user alteration of the medical data in the received marked up document (rejected as per claim 4 above. The Examiner considers an “update” to include storage of altered data), and

upon an end of session request by the user the altered medical data is caused to replace the medical data in a patient database that stored the medical data (Taylor: col 3, Ins 57-59; Fig 1, Block 8. The Examiner notes that a user would select Enter on the keyboard after entering data in “word processor templates”, and considers this to be a form of end of session request that replaces the old data, the session being considered to be the steps of the data alteration/entry process prior to selecting Enter).

L. As per claim 13, Taylor discloses the patient evaluation method of claim 8, further comprising

storing a user alteration of the medical data in the received marked up document (rejected as per claim 4 above. The Examiner considers an "update" to include storage of altered data), and

upon a cancel request by the user the altered medical data is deleted (Taylor: col 3, lns 57-59; Fig 1, Block 8. The Examiner notes that a user might elect to not save the data after entering data in "word processor templates", and considers this to be a form of cancel request that deletes the entered data).

M. As per claim 14, Taylor discloses a patient evaluation method, comprising:

dynamically creating a marked up document based on a configuration database, with the configuration database including form data for medical evaluation forms (rejected as per the steps of claim 1a and 1b above);

transmitting the marked up document through a transmission channel to a user having a browser capable of receiving and displaying the received marked up document (rejected as per the step of claim 1c above);

monitoring for a user addition of medical data to the received marked up document (rejected as per claim 4 above. The Examiner considers an “update” to include monitoring for addition of new data.);

storing the medical data (rejected as per claim 4 above. The Examiner considers an “update” to include storage of data); and

transmitting a combination of the stored medical data and the marked up document through the transmission channel to the user (rejected as per the step of claim 1c above).

N. As per claim 15, Taylor discloses the patient evaluation method of claim 14, wherein the stored medical data is

stored in a patient database upon a determination that the medical data is sufficiently unique to identify a patient corresponding to the stored medical data (Taylor: col 16, lns 43-45. The Examiner considers that the referenced analysis includes a form of determination of uniqueness.).

O. As per claim 16, Taylor discloses the patient evaluation method of claim 15, wherein

Art Unit: 3626

if the medical data is not sufficiently unique (Taylor: col 2, lns 30-34, reads on "Enforcement of Format and Content Requirements") then sending an error message to the user indicating that additional medical data is necessary (Taylor: col 4, lns 29-37. The Examiner considers "error checking" to include sending an error message.).

P. As per claim 17, Taylor discloses the patient evaluation method of claim 14, further comprising

determining whether the user is authorized to receive the marked up document (rejected as per claim 7 above).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor as applied to claim 1 above, and further in view of Myers et al (US Pat# 2002/0004806, hereinafter Myers).

A. As per claims 6 and 18, Taylor discloses the patient evaluation apparatus of claim 1, wherein the transmission channel is

an Internet or Intranet channel (Taylor: col 5, lns 17-22, note the use of the Internet, in particular the effect of the referenced invention to improve transfer over the Internet and within Intranets.).

The teachings of Taylor fail to explicitly disclose
the marked up document is a HTML/ASP document.

However this feature is well known in the art as evidenced by the teachings of Myers (Myers: [0025]).

It would have been obvious to one of ordinary skill at the time of the invention to incorporate the teachings of Myers within the system of Taylor with the motivation of providing automated formatting of documents (Myers: Abstract) and improving system

Art Unit: 3626

security by restricting the use of “cookies” which might contain computer viruses (Myers: [0005]-[0006]).

7. As per claims 19-24 and 25-29, they are claims directed to a “readable medium for use in a computational device” which repeats the same limitations of claims 8-13 and 14-18 respectively, the corresponding method claims, as collections of instructions stored on readable media for use in a computational device, as opposed to a series of process steps. Since the teachings of Taylor and Myers disclose the underlying process steps that constitute the method of claims 8-13 and 14-18, it is respectfully submitted that they likewise disclose the instructions that cause the computational device to perform the steps as well. As such, the limitations of claims 19-24 and 25-29 are rejected for the same reasons given above for claims 8-13 and 14-18.

Response to Arguments

8. Applicant's arguments in the response filed 06/19/2006 have been fully considered but they are not persuasive.

A. Starting on pg 9 to the top of pg 10, Applicant argues that the applied reference, Taylor, fails to teach certain features of claim 1 and its analogous claims. It should first be pointed out that most of Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. A narrative is presented describing certain

Art Unit: 3626

material disclosed in the specification. The Examiner notes that most of this material is not claimed, and thus the relevance to the claims or applied reference is not apparent.

B. At the bottom of pg 10 to the top of pg 11, Applicant asserts that the second step of claim 1 is not taught by Taylor – namely

a dynamic generator to create a marked up document based upon the form data.

The Examiner has reviewed the passages cited for this feature and re-asserts that they disclose dynamic document generation, i.e. a document is assembled based on format instructions and document-specific content. For the “marked up” component, Applicant is directed to the passages provided for the rejection of feature 1c. The Examiner points out that Taylor teaches the use of the Internet as a transmission network, and the use of Word (and other similar, well-known software applications) to generate documents, and notes that a common format for a Word document is HTML.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Thurs 8:30 -6 and alternate Fri 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

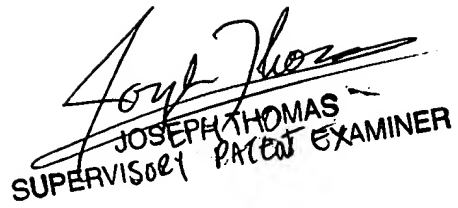
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/879,993
Art Unit: 3626

Page 15



MG
06/23/2006



JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER